

Appln. No.: 09/963,311
Amendment Dated: August 18, 2005
Reply to Office Action of: June 20, 2005

MAT-8187US

Remarks/Arguments:

The pending claims are 1-16. Claims 1, 8, 14, and 16 have been amended. No new matter is entered therein.

Claims 1-2, 7-8, and 13-16 have been rejected under 35 U.S.C. § 102(e) as anticipated by Borella et al. (U.S. Patent no. 6,731,642). Claim 1, as amended, recites, in part:

wherein said first modem, after being assigned with an IP address, transmits a telephone number of the first telephone set and the assigned IP address to the server to register the telephone number and the assigned IP address in the server, and acquires an IP address corresponding to a telephone number of the second telephone set from the server, when the telephone number of the second telephone set is entered in the first telephone set, and then using the acquired IP address transmits a connection request to said second modem.

In applicant's invention, the first modem transmits a connection request to the second modem when the IP address corresponding to the telephone number of the destination telephone is acquired by the first modem from the server. (page 4, lines 3-5) This claim language is supported by applicant's disclosure stating that "using the received IP address, the modem 1 transmits a connection request to the destination side modem 10 through the Internet 6." (page 6, lines 12-14). Claim 1 has been amended to recite this feature more clearly. It recites, in part, that

said first modem. . .acquires an IP address corresponding to a telephone number of the second telephone set from the server. . ., and then using the acquired IP address transmits a connection request to said second modem. (emphasis added)

Paragraph 18a at the top of page 7 of the Office Action contends that Borella teaches "a database used by server 34 that is relational and given a station number, is able to determine the address of that station as well as addresses of the router and gatekeeper associated with that station." The aforesaid contention interprets Borella too broadly.

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When Borella is analyzed in detail, it is seen that Borella does not disclose all of the features recited in amended claim 1. Modem 18 in Borella does not acquire an IP address corresponding to the telephone number of the second telephone set 26 from the server 34. Instead, server 34 transmits a message to first gatekeeper 30 (col. 8, lines 23-25) and another message to second gatekeeper 32. (col. 8, lines 60-62). Neither of these messages are equivalent to the first modem acquiring an IP address corresponding to a telephone number of the second telephone set from the server, as recited in amended claim 1. Although server 34 is also involved in registering caller station 24 and callee station 26, these registration processes also do not involve the first modem acquiring an IP address corresponding to a telephone number of the second telephone set from server 34. (col. 7, lines 24-62)

In addition, Borella does not use any such IP address to transmit a connection request to the second modem 20. Instead, first modem 18 allocates a caller address which is sent to gatekeeper 30 via a first address response message. (col. 8, lines 34-44). Note that in this step, first modem 18 is not transmitting a connection request to second modem 20. Later in the process, first modem 18 transmits a ringing message to first telephony interface 22. (col. 9, lines 44-46). Again, this is not a connection request to second modem 20.

Paragraph 18b on page 7 of the Office Action contends that column 9, lines 19-35 of Borella teaches a ring message that is sent to a callee station. To the extent that paragraph 18 contends that the ring message is sent by first modem 18 to second modem 20, it is respectfully submitted that the statement is not correct. Instead, referenced the ring message is sent to second telephony interface 28. (col. 9, lines 22-24). In addition, the ring message is sent by second modem 20, not by first modem 18. (col. 9, lines 22-23) Paragraph 18b also contends that column 8, lines 16-51 also teaches a ring message being sent. Applicants disagree and contend that the cited portion of column 8 does not refer to a ring message.

Furthermore, Borella states that elements other than first modem 18 transmit connect messages. Specifically, it states that second telephony interface 28 transmits a first originating connect message. Then, second modem 20 transmits a second

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originating connect message to first modem 18. (col. 9, lines 52-64). Although modem 18 does transmit a connect message, its connect message is transmitted to first telephony interface 22 (as indicated previously) and provides "a user discernible indication, to caller station 24 that callee station 26 has answered the telephone call." (col. 10, lines 5-12) (emphasis added). Note again that first modem 18 is not using an acquired IP address to transmit a connection request to second modem 20, as recited in amended claim 1.

For all of the above reasons, amended claim 1 is not subject to rejection under 35 U.S.C. § 102(e) as anticipated by Borella. Since claims 2 and 7 depend from amended claim 1, they are also not subject to the same rejection.

Claim 8 has been amended in a manner that is identical to the amendment to claim 1. Accordingly, amended claim 8 and dependent claim 13 are not subject to the same rejection.

Claim 14 has been amended in a very similar way. Paragraph (d) has been amended so that it now recites:

using the acquired IP address, transmitting a connection request from said caller to a destination having said telephone number.

This recitation is the method equivalent of the apparatus amendments to claims 1 and 8. Accordingly, amended claim 14 and dependent claim 15 are not subject to the same rejection.

Claim 16 has also been amended in a similar way. It now recites, in part:

an output port for transmitting a connection request from said caller to a destination and for attempting to establish connection with said destination having said one of said telephone numbers based on the one of said transmitted IP addresses corresponding to said one of said telephone numbers. (emphasis added)

Accordingly, amended claim 16 is not subject to the same rejection.

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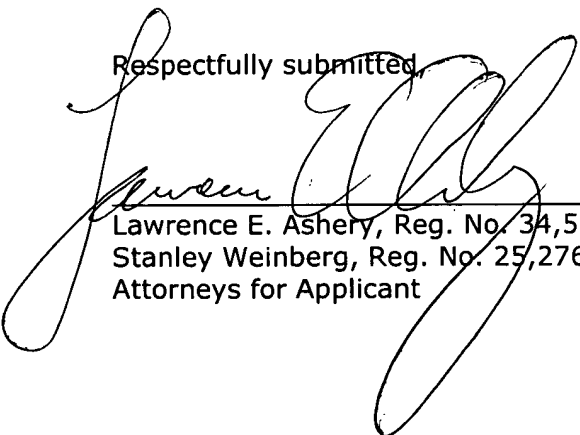
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Claims 3-5 and 9-11 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Borella in view of Thornton et al. (U.S. Patent No. 6,363,065). Applicant incorporates by reference the arguments he made regarding the rejections of these claims in his March 11, 2005 response. For those reasons, dependent claims 3-5 and 9-11 are not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over Borella in view of Thornton.

Claims 6 and 12 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Borella in view of Moon (U.S. Patent No. 5,864,758). Applicant incorporates by reference the arguments he made regarding the rejections of these claims in his March 11, 2005 response. For those reasons, dependent claims 6 and 12 are not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over Borella in view of Moon.

For all of the above reasons, applicant contends that this application is not in condition for allowance.

Respectfully submitted,


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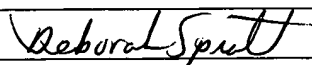
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August 18, 2005

Deborah Spratt



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